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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/529,172 08/22/00 EDELMAN

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001444 HM12/0615
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EXAMINER

MEHTA, A

ART UNIT

PAPER NUMBER

1638

DATE MAILED:

8
06/15/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/529,172

Applicant(s)

EDELMAN ET AL.

Examiner

Ashwin Mehta

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1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claims 1-64 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-18, 25-36, and 54-58, drawn to a first product, a genetically stable, transformed Lemnaceae plant; a first method, for the stable genetic transformation of Lemnaceae plants comprising incubation with Agrobacterium cells, and a method for production of a product of interest, comprising growing said first product to allow production of a product of interest.

Group II claim(s) 19-22, 62, and 63, drawn to a second method, for the Agrobacterium-mediated genetic transformation of any plant.

Group III, claim(s) 23-24, drawn to a third method, for the stable genetic transformation of Lemnaceae, comprising microinjection of Agrobacterium cells.

Group IV, claims 37-44, drawn to a second product, a booster medium for enhancing Agrobacterium virulence.

Group V, claim(s) 45 and 46, drawn to a fourth method, for maintaining morphogenetic Lemnaceae calli.

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Group VI, claim(s) 47-51, 60, 61, and 64, drawn to a fifth method, for the production of highly regenerative calli.

Group VII claim(s) 52-53, drawn to sixth method, for the production of any stable transformed plants.

Group VIII, claim(s) 59, drawn to a seventh method for forming Lemnaceae calli by separating between the mother frond and, using a plucking motion.

The inventions listed as Groups I-VIII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The method of transformation of Lemnaceae of Group I is not shared with the method for transformation of any plant of Group II, microinjection step of the method of Group III, the medium of Group IV, the maintenance of calli of Group V, the production of highly regenerative calli of any plant type of Group VI, the production of any stable transformed plant of Group VI, and the method for forming Lemnaceae calli of Group VIII. The non-Lemnaceae plants of Group II is not shared with Groups I, III, V, and VIII, nor with the booster medium of Group IV, nor the method of Group VII, The microinjection of Group III is not shared with Groups I, II, IV-VII. The booster medium of Group IV is not shared with Groups II, III, V-VII. The maintenance of calli of Group V is not shared with the other


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groups. The production non-Lemnaceae plants of Group VI is not shared with Groups I, III, IV, V, and VII. The plucking motion of Group VII is not shared with the other groups.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication should be directed to Examiner Ashwin Mehta, whose telephone number is (703) 306-4540. The Examiner can normally be reached Monday-Thursday and alternate Fridays, from 8:00 A.M. - 5:30 P.M. The fax phone number for the group is (703) 305-3014. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Paula Hutzell, can be reached at (703) 308-4310. Any inquiry of a general nature or relating to the status of the application should be directed to THE MATRIX CUSTOMER SERVICE CENTER, whose telephone number is (703) 308-0196.



ASHWIN D. MEHTA, PH.D
PATENT EXAMINER

06/13/01